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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,164	11/22/2003	William R. Graves	480927.00002	2344
26735	7590	10/19/2005		
QUARLES & BRADY LLP FIRSTAR PLAZA, ONE SOUTH PINCKNEY STREET P.O BOX 2113 SUITE 600 MADISON, WI 53701-2113			EXAMINER HAAS, WENDY C	
			ART UNIT 1661	PAPER NUMBER

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,164

Applicant(s)

GRAVES ET AL

Examiner

Wendy C. Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the photographs are mounted on paper (card stock). 37 CFR 1.84(e) states: "photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section." Applicant should note that the photographs may not be mounted on separate paper (or card stock) but must, instead, be printed/developed on a single sheet. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The claim is rejected under 35 U.S.C. 102(b) as failing to patentably distinguish over Huxley et al. The Examiner finds no patentable distinction between the description of the claimed plant in the present specification and the description of the species *Alnus maritima* in Huxley et al.

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***Objection to the Disclosure***

**37 CFR 1.163**

**The following is a quotation of section (a) of 37 CFR 1.163:**

*(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

**35 USC § 112**

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

**As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164**

**(reproduced below) are controlling:**

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

**In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited.**

**The following is a quotation of 35 U.S.C. 162:**

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure remains objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Applicants must provide color designations with reference to the employed color chart for the following botanical structures of the claimed plant: Trunk, branches, petioles, stipules (upper and lower surface, if any), upper and lower leaf veins, lower side of mature leaf, colors of fall foliage variegation, new branch growth, roots, and a complete description of the catkin coloration (multiple colors are illustrated) as well as the peduncles of the catkin. As the claimed plant is monoecious, the male and female catkins must be separately described. More information is required. Applicants argued that the color designations already of record are sufficient to patentably distinguish the claimed plant. The Examiner disagrees.

B. Page 3, lines 5-12: Applicants appear to describe the species in general rather than the claimed plant. This description of the species constitutes the bulk of the descriptive portion of the disclosure. Applicant must provide a detailed description of the specific plant claimed. The description must state the age of the plant described and its location of culture as well as the time of year the plant was observed and the specific cultural conditions (i.e. light, temperature, water, etc.) the plant was grown under. The description should include, but is not limited to:

- Root size, shape, color
- Plant height and diameter
- Trunk color, texture, diameter at a given height from the ground
- Approximate number of branches

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- Branch color, length, diameter and internode distance
- Petiole color, length and diameter
- Leaf color, venation, shape, margin shape, apex shape, base shape, texture, length, diameter
- Number of catkins (male and female)
- Catkin shape, colors, number of flowers per inflorescence, pollen produced, time and length of bloom
- Pedicel length, diameter, color
- Fruit/seed number, shape, color, viability
- Disease resistance
- Heat/Cold/Salt tolerance

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

***Claim Rejection***

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the drawings.

***Remarks***

Applicants argue that the disclosure provides a reasonably complete botanical description of the claimed plant that patentably distinguishes it from other known varieties. The Examiner disagrees. First, the disclosure, as written, is not a reasonably complete botanical disclosure. Second, the bulk of the disclosure recited is a description of the species in general. The botanical characteristics recited in lines 5 through 12 of page 3 are the largest part of the botanical disclosure and are preceded by the phrase "*A. maritime*, as a species, . . ."

Applicants also note that no copies of patents were provided with the previous Office action. The Examiner supplied a references cited form that noted specific patents. It is no longer the policy of the Office to provide copies of patents with Office actions, as they are available online. The Examiner intended for applicants to consult the patents cited and apologizes for any confusion that may have occurred.


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*Future Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday, Tuesday and Thursday from 9:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
W. C. Haas  
Patent Examiner  
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